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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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John F. Acres

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BEYER WEAVER LLP

P.O. BOX 70250

OAKLAND, CA 94612-0250

EXAMINER

DEODHAR, OMKAR A

ART UNIT

PAPER NUMBER

3714

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/558,933	<b>Applicant(s)</b> ACRES, JOHN F.	
	<b>Examiner</b> OMKAR A. DEODHAR	<b>Art Unit</b> 3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 29 April 2008.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 22-34 is/are pending in the application.

    4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 22-34 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All    b) ☐ Some \*    c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_.

4) ☐ Interview Summary (PTO-413)  
    Paper No(s)/Mail Date \_\_\_\_\_.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### Non-Final Rejection

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 22, 27 & 31 recite "wherein the one or more regions are portions of the game image that if overlaid would not interfere with the **enjoyment** and operation of the game".

The term "enjoyment" is subjective, what may not interfere with one player's enjoyment might ruin another player's enjoyment. In other words, the claim language does not ensure that placement of a player tracking image will not interfere with all players' enjoyment. Therefore, the limitation is not enabled.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 22-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wynn et al. (US 5,971,271, hereafter: Wynn) in view of Aoshima et al. (US 6,241,524, hereafter: Aoshima).**

Wynn discloses a gaming device in which player tracking information and game images are simultaneously displayed on the same display, (Figure 19 shows a player's image displayed simultaneously with game images on the same display).

Wynn further discloses the following features:

Player tracking input device, (Figure 7 shows a card reader);

Communications interface to provide player information to a host machine, (Figure 7 shows communication via fiber optic signal between a player tracking device and a slot marketing system coupled to a customer database);

A display device, (Abstract);

Game electronics configured to provide game images and output information, (Figure 3 is one of many figures that shows various game electronics disclosed by Wynn);

Additionally, as shown in Figure 19 and discussed in Col. 8. Lines 34—55, player identification information is combined with game images.

Figure 17 discloses that prior to sending a message stream (video, audio, image, or a combination thereof) to a player at a gaming machine, the machine must not be in use. This teaches that if a player is in the middle of game play, the message will be postponed, or not sent at all, so as to not interfere with the game. If a player is in the middle of a game, then the entire game region is important and a message stream shall not be sent. Conversely, if a player is not in the middle of a game, then the entire game region is essentially unimportant, and a message stream may be sent.

Wynn's player tracking image shown in Figure 19 is embedded, or part of the overall game image.

Wynn does not teach displaying information or an image (as in a player tracking image) that when overlaid on the screen does not interfere with the game image.

In a related invention, Aoshima teaches a message window (80) that is transparent such that it does not interfere with the game image. Thus, Aoshima teaches the concept of displaying game data on the game screen without interfering with the actual game image. See Aoshima, Figure 9, Col. 9: Lines 65-67 & Col. 10: Lines 1-9. Note that player tracking data is a form of game data.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Wynn such that a player tracking image could be displayed in a manner so as to not block out (or interfere) with the image shown on the game screen, as taught by Aoshima. This is considered a substitution of known

elements with the predictable results of conveying game information without interfering with a game display (note, these predictable results are acknowledged by Aoshima in the cited portions.) Although the term "enjoyment" as used in the claims & addressed in the section 112 rejection above is subjective, one of ordinary skill in the art would recognize that game images disrupting game play would irritate some players.

Wynn discloses the usage of commercially available hardware that includes a video overlay card, (Please refer to the table of components in Col. 12.) A video overlay card is listed as one of the preferred components used in the system. A specific manufacturer and model number are disclosed. This emphasizes the video overlay card's integral role in the system. It must also be understood that individual components (video overlay card, player tracking card reader, video interface module, etc.,) comprise a larger gaming system; thus each component participates in providing the gaming experience. The video overlay card and display must be coupled with the game electronics. If they were not coupled to the game electronics, the system would not work.

**Claims 23-26, 28-30 and 32-34:**

Player tracking information includes player ID, (Figure 7), animated graphics, (Col. 8. Lines 34-55 discloses a concierge appearing with the game image to congratulate a player), game images include reels, (reels are inherent to slot machines), and a card reader, (Figure 7).

***Response to Arguments***

Applicant's arguments filed have been fully considered but are moot in view of the new grounds of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMKAR A. DEODHAR whose telephone number is (571)272-1647. The examiner can normally be reached on M-F: 8AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Corbett Coburn/  
Primary Examiner  
AU 3714

